



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

HC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/895,493 07/16/97 SAITO M 58800.919C

022804
HECKER & HARRIMAN
SUITE 2300
1925 CENTURY PARK EAST
LOS ANGELES CA 90067

LM02/1221

EXAMINER

SAYADIAN, H

ART UNIT

PAPER NUMBER

2766

26

DATE MAILED:

12/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/895,493

Applicant(s)

MAKOTO SAITO

Examiner

Hrayr A. Sayadian

Group Art Unit

2766



☒ Responsive to communication(s) filed on Sep 15, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 95-142 is/are pending in the application.

Of the above, claim(s) 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122 are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

GENERAL

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

ELECTION/RESTRICTION

Information Regarding the Election Requirement

2. Claims 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122, 124, 128, 130, 132, 134, 138, and 140 are withdrawn from further consideration by the Examiner, 37 C.F.R. 1.142(b), as being drawn to non-elected species Election was made **without** traverse in Applicant's Response to Examiner's office action requiring election between species, which response was received at the USPTO on 8-24-1998.
3. *The election of species requirement is still deemed proper and is therefore maintained as FINAL.*
4. This application contains claims 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122, 124, 128, 130, 132, 134, 138, and 140, which are drawn to an invention nonelected with traverse in Paper No. 18. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

OBJECTIONS/REJECTIONS NOT BASED ON PRIOR ART

DISCLOSURE: Specification

5. A substitute specification in proper idiomatic English and in compliance with 37 C.F.R. 1.52(a) and (b) is required. A substitute specification is required because the detailed specification contains numerous corrections, making the detailed description ambiguous and generally unclear, thus making it difficult to examine and difficult to print when the application is allowed.

No new matter may be introduced.

The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

REJECTIONS BASED ON PRIOR ART

6. Claims 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123, 125-127, 129, 131, 133, 135-137, 139, 141, and 142 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dolphin ('746) [hereinafter Dolphin].

Examiner notes that the independent claims recite, the optional steps of choosing one of displaying, editing, storing, copying, and transferring. Claims 105, 121, and 137 further recite steps that are completely optional and therefore need not be met. The various recitation of keys are read to include the scope of the utilization permit key being the crypt key which comprises a display permit key.

With respect to the independent claim 95, Dolphin teaches a database (21 in Fig. 1) supplying encrypted data (22 in Fig. 1) to a user 26 in Fig. 1); in response to the user's request (27' of Fig. 2) a key control center (23 of Figs. 1 and 2) supplies a crypt key to the user (27" in Fig. 2); the user displays the data after decryption by the decrypt key (see, e.g., 54-58 of column 6; note that user 26 has a computer 31 which includes a monitor to display the data--which "can include, for example, video, image, photographs, databases, sound, [and] software," see, lines 17-18 of column 5). The decryption is under a copyright control program (the decryption algorithm in the PCMCIA card 29 and on the CD 70D and 70E of Fig. 10).

With respect to claim 97, Dolphin teaches supplying copyright control program (elements 70D, 70E in Fig. 10) by the database (publisher 21 of Fig. 1). With respect to claim 99, Dolphin teaches copyright control program using copyright information (see, e.g., line 48 of column 12 to line 48 of column 13; see especially lines 45-47 of column 13 explaining that the counter updating the encryption information--anticipating copyright information because it updates and enables access to new copyrighted data--of the new data is provided as part of the CD-ROM). With respect to claim 103, Dolphin teaches entering the copyright information into the data being sent (see, e.g., lines 45-47 of column 13). With respect to claim 104, Examiner notes the further recitation of "copyright information is entered as a computer virus" is treated as intended outcome of a broadly scoped limitation of entering the copyright information; as such Examiner notes that in Dolphin, providing the copyright information is by associating it with the other data which is within the scope of entering the copyright information as a computer virus because a the copyright information is associated with data as a computer virus may be associates with data. With respect to claim 105, Examiner notes that the further recitations are cast in optional language that are not necessarily present ("when ...") and therefore have Dolphin anticipating them when they are not present. Claims 101, 107, 109-111, 113, 115, 117,

119-121, 123, 125-127, 129, 131, 133, 135-137, 139, 141, and 142 recite limitations addressed in the specifically rejected claims and are similarly rejected.

Regarding claims 99, 103, 109, 115, 119, 125, 131, 135, and 141, Examiner notes that copyright information data inherently accompanies data. With respect to claims 104, 110, 120, 126, 136, and 142, Examiner has read "as a computer virus" as intended use with scope including the copyright information propagating along with the data. Examiner notes that in data amenable to computer use, the copyright information will automatically propagate.

7. Moreover, Claims 99, 103, 104, 109, 110, 115, 119, 120, 125, 126, 131, 135, 136, 141, and 142 are rejected under 35 U.S.C. § 103 as being unpatentable over any of Dolphin (as applied in paragraph 6) and further in view of U.S. copyright law.

If in Dolphin the update counter is not deemed to anticipate copyright information being entered into the transmitted data, then Examiner notes that U.S. copyright law requires including copyright notification information along with copyrighted data to win actual infringement damages from unauthorized infringers. To avoid being limited to statutory damages, therefore, it would have been obvious to include copyright information with the protected data. Examiner has read "as a computer virus" as intended use with scope including the mark propagating along with the data. Examiner notes that in data amenable to computer use, the copyright information as data will automatically propagate.

REJECTIONS BASED ON DOUBLE PATENTING

8. Claims 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123, 125-127, 129, 131, 133, 135-137, 139, 141, and 142 are directed to an invention not patentably distinct from claims 1-24 of commonly assigned U.S. Patent No. 5,646,999. Specifically, claims 1-24 in said Application anticipate the claims in this Application. In line with Applicant's admission, as stated in the third paragraph on p. 33 of Applicant's response to the First Action, US S.N. 08/549,271, which is now U.S. Pat. No. 5,646,999, teaches using two crypt keys to edit data; thus controlling copyrights of the data. Examiner notes that this anticipates the use of a crypt key along with a single alternate permit key and its corresponding step. For example, in U.S. Pat. No. 5,646,999 the edit permit key and its corresponding steps, as one of the optional limitations recited in the claims of this application. See, supra paragraph 7 for explanation of the scope of the claims in this application.

9. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy

reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

10. Claims 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123, 125-127, 129, 131, 133, 135-137, 139, 141, and 142 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Pat. No. 5,646,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims of said patent anticipate the claims in this application. In line with Applicant's admission, as stated in the third paragraph on p. 33 of Applicant's response to the First Action, US S.N. 08/549,271, now U.S. Pat. No. 5,646,999, teaches using two crypt keys to edit data; thus controlling copyrights of the data. Examiner notes that this anticipates the use of a crypt key along with a single alternate permit key and its corresponding step. For example, in U.S. Pat. No. 5,646,999 the edit permit key and its corresponding steps, as one of the optional limitations recited in the claims of this application.
11. Claims 99, 103, 104, 109, 110, 115, 119, 120, 125, 126, 131, 135, 136, 141, and 142 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Pat. No. 5,646,999 and further in view of U.S. copyright law.

If any of the cited prior art is deemed deficient in teaching including copyright information along with the data, then Examiner notes that U.S. copyright law requires including copyright notification information along with copyrighted data to win actual infringement damages from unauthorized infringers. To avoid being limited to statutory damages, therefore, it would have been obvious to include copyright information with the protected data. Examiner has read "as a computer virus" as intended use with scope including the mark propagating along with the data. Examiner notes that in data amenable to computer use, the copyright information as data will automatically propagate.

RESPONSE TO APPLICANT'S REMARKS TO THE LAST ACTION

12. Applicants' arguments received 9-15-1999 have been fully considered but they are not persuasive. Applicant argues (1) that Dolphin fails to show a display permit key; (2) that US copyright law fails to compensate for the deficiencies of Dolphin; and (3) copyright information is not anticipated by Dolphin because Dolphin does not anticipate the name of the authors of the data being processed by the computer handling the data.

Regarding arguments (1) and (2), Applicant is directed to the 102 anticipation of the claims by Dolphin, and the 103 rejection of the claims over Dolphin in view of US copyright law.

Regarding argument (3), Examiner notes that Applicant argues a selected portion of the detailed description rather than how the language of the claims specifically distinguish over the cited prior art. Although the claims are interpreted in light of the specification, limitations from the specification generally are not read into the claims. *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. *In re Vogel*, 164 USPQ 619, 622 (CCPA 1970).

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541, 550 - 51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. § 101 and 102. In the section 102 rejection, the examiner explained that the claim was anticipated by

a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that "(reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, e.g., the impermissible importation of subject matter from the specification into the claim.).

TIME PERIOD FOR RESPONSE

This Action Is Made Final

13. Applicant's amendment necessitated the new grounds of rejection.

Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION.

In the event a first response is filed within two months of the mailing date of this final action and the advisory action is not mailed until after the end of the three-month shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. 1.136(a) will be calculated from the mailing date of the advisory action.

IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

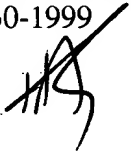
INFORMATION ON HOW TO CONTACT THE USPTO

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hrayr A. Sayadian whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday through Friday, from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Gail Hayes, can be reached on (703) 305-9711. The fax phone number for Technology Center 2700 is (703) 308-9051 or 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 305-3800 or 305-4700.

Hrayr A. Sayadian
11-30-1999



GAIL O. HAYES
SUPERVISORY PATENT EXAMINER
GROUP 2700